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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,576	12/29/1999	CASSANDRA J. MOLLETT	FDC-0140-PUS	2400

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EXAMINER

RUDY, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 10/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/474,576

Applicant(s)

MOLLETT ET AL.

Examiner

Andrew Joseph Rudy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

I. Claims 1-5 are pending. Claims 1-5 are still rejected from the July 19, 2002 Office Action.

NOTICE OF NON-RESPONSIVE AMENDMENT

II. The reply filed on September 24, 2002 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): the objections to the drawings remain. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, Applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

III. Applicants argue that "The drawings are clearly sufficient to facilitate an understanding of Applicant's invention" and requests withdrawal of the objections to the drawings. The examiner is not in agreement. It is noted "the express language of 37 C.F.R. 1.81(b) permissively allows drawings that facilitate understanding of an invention such as flow sheets for processes." The Examiner couldn't agree more. After careful review of the drawings figures 1-3, numerous claimed features from claims 1-5 are not contained in the drawings. The Examiner respectfully requests Applicants to show in flow chart form the claimed method steps. It is noted that the Examiner's observation regarding claims 1 and 4 and the features contained therein has been interpreted in such a manner. The

examiner is cognizant that each feature illustrated need not be claimed. However, Applicant is fully within the law in not illustrating features that are not claimed if not required for an understanding of the invention.

IV. The Examiner cites three independent reasons for his position.

V. First, as far as 37 CFR 1.83(a) and completeness is concerned, it is immaterial whether or not one skilled in the art would understand the claimed invention or that “Figs. 1- 3 adequately facilitate understanding of the processes set forth in claims 1- 5.” 37 CFR 1.83(a) states in part:

(a) The drawings in a nonprovisional application *must show every feature* of the invention specified in the claims. However, conventional features ... should be illustrated in the drawing in the form of a graphical drawing symbol or labeled a representation (e.g. a labeled rectangular box).[Emphasis added.]

1. The rule expressly states the “application must show every feature of the invention specified in the claims.” *Id.* The Examiner respectfully states that this rule is clear on its face. In other words, if its in the claims, it must be shown in the drawings.

In fact, even if an element was conventional,¹ 37 CFR 1.83(a) nevertheless requires the features to be shown in the drawings—albeit a graphical drawing symbol or labeled representation. Therefore, arguments that features are old and well known or one of ordinary skill in the art would be able to ascertain the claimed features from the drawings or specification are not persuasive.

In this case, the Examiner will presume (for Applicants' benefit) that all features shown in the figures are not conventional. However, if Applicants believe certain features in any claimed method are conventional, the Examiner respectfully requests Applicants to properly delineate such features in their drawings as required.

For these reasons alone, Applicants' arguments are unpersuasive.

VI. Additionally, the Examiner notes that figures 1 and 2 clearly are not directed to a method, while only figure 3 is directed to a method or process.

VII. The second reason for requiring Applicants to show all their method steps is to assist the public (and examiners)—once Applicants' application issues as a patent—in ascertaining the

¹ The Examiner notes the following definition of conventional: "conventional, 2 ... b: lacking originality ... c (1) : ORDINARY, COMMONPLACE" Merriam Webster's Collegiate Dictionary, Tenth Ed., Merriam Webster, Inc., 1997.

invention so that Applicants' published patent can be used against others as prior art. U.S. patent application numbers 'US 2002/0096320 A1', 'US 2002/00997406 A1', and 'US 2002/0102749 A1' are published applications with 5,395 claims, 6,632 claims, and 6,632 claims respectively!² How does an Applicant reasonable expect the public to follow and comprehend such applications without a flow chart for the method claims? While Applicants' current application does not contain the number of claims listed above, the reasoning is still the same.

Theoretically, Applicants in the current application are also free to recite over 6000 claims (although the Examiner *strongly* encourages Applicants not to do this). Published patents within class 705 are now routinely issuing with specifications over 100 pages. Whether its 14 claims or 6000 claims, unless the claimed methods are shown in flow chart form, it is extremely difficult to comprehend the invention (for prior art purposes) while searching unless the claims are in flow chart form.

For these reasons alone, Applicants' arguments are unpersuasive.

² A search reveals that there are over 50 published applications with at least 5000 claims.

VIII. Finally, Applicants apparently are arguing that features from claims 2 and 5 are inherent in figure 1. If understood correctly, Applicants argue that these shown steps inherently includes the steps of “labeling” or “pre-determined category” and need not be shown in a separate drawing. The Examiner respectfully disagrees.

If Applicants were allowed to follow such a practice, drawings of such could be illustrated as a single drawing with a single box labeled “System” while method claims could be illustrated with two rectangular boxes in flow chart form labeled “Method Steps.” Applicants current argument that the claimed features are inherent within the boxes labeled Fig. 1 would then be appropriate. This line of reasoning clearly defeats the principle purpose of the drawings: “for the understanding of the subject matter sought to be patented.”³ Furthermore, because issues of how much patentable weight to give structural limitations in method steps continually arise, Applicants’ delineation of what specifically are the steps in their claims is of great importance.

For these reasons alone, Applicants’ arguments are unpersuasive.

VIII. Because Applicants have neither shown the claimed features nor successfully argued their inclusion in the drawings is not necessary, Applicants’ response is technically non-responsive. The Examiner cautions that the discretion shown by the Examiner in this or any previous Office Action is in no way a waiver—either expressly

³ 35 U.S.C. 113 (1999).

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or implicitly—of the drawing requirements as stated in 37 C.F.R. 1.85 and other sections.

Conclusion

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Joseph Rudy whose telephone number is 703-308-7808. The examiner can normally be reached on Tuesday thru Friday, 7:30 a.m until 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski can be reached on (703) 308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

October 2, 2002

Andrew Joseph Rudy